



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,562	09/27/2000	Thomas G. Woolston	032997-036	7517

20985 7590 05/18/2004
FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/670,562

Applicant(s)

WOOLSTON, THOMAS G.

Examiner

James A. Kramer

Art Unit

3627

NY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 12, 13, 14, 15, and 17 rejected under 35 U.S.C. 102(b) as being anticipated by Electronic Auction Systems (hereinafter EASE) as taught by the following articles
“Electronic Agricultural Auctions in the United Kingdom” (hereinafter agricultural) and
“Electronic livestock auctions starting in Britain” (hereinafter livestock).

EASE teaches suppliers of agricultural products feed information about the products for sale into IBM compatible PCs or terminals at the local franchise office (Agricultural; column 3; lines 8-20). Examiner notes that this corresponds to authorizing a seller participant to post an item for auction at an Internet auction site. In light of Applicant’s specification the EASE’s suppliers of agricultural products are the same as Applicant’s sellers and the local franchise office of EASE corresponds to Applicant’s consignment nodes.

Referencing Agricultural, Figure 1; EASE teaches that the farmers input product specification information into the computers. Examiner notes that at the time the articles were written the system of EASE was used primarily for cattle, sheep, pigs and grain. Therefore, it is inherent to the system that the product information entered by the farmers would include one of these four categories. Examiner notes that without this information a buyer/bidder would have no way of know which product he/she is bidding on. As such, the step of designating a category from a list of categories (i.e. cattle, pigs, sheep and grain) is necessarily present in the teaching of EASE.

EASE further teaches that the information from the suppliers is then sent to the company in Thainstone (Agricultural; column 3; line 20) where it is stored on a VAX server. From there the information is made available electronically to buyers in the form of an electronic catalogue (Agricultural; column 3; lines 24-29). Examiner notes that one of ordinary skill will recognize that making the information available electronically via a VAX server from DEC is equivalent to utilizing the Internet or World Wide Web. In addition, Examiner notes that by receiving the information and then making it available as an electronic catalogue, EASE is processing the received information at the host computer system into presentation format with a database-to-presentation format-formatting program.

EASE goes on to teach that buyers have direct access to the system, using their own PCs and modem links (Agricultural; column 3; lines 32-34). This corresponds to Applicant's limitation of presenting the presentation-formatted information (electronic catalogue) to a plurality of Internet participants (buyers using modem links).

EASE teaches a lot appears on the computer screen of the buyers at a certain starting price. A buyer makes an offer to buy when he/she presses a button on his/her keyboard (receiving at the host computer at least one bid for the auctioned item from at least one of the Internet participants). The price of the product increases if further offers to buy are registered. The product is declared sold, when 15 seconds have elapsed since the last offer to buy (Agricultural; column 4; lines 1-11). Examiner notes that the processes of having a lot appear on the computer screen, corresponds to Applicant's limitation of opening an auction process to the plurality of Internet participants. In addition, EASE's teaching of the product being declared sold when 15 seconds have elapsed corresponds to Applicant's limitation of automatically

closing the auction process to the Internet participants based on a predetermined condition (i.e. when 15 seconds have elapsed since the last offer to buy).

EASE further teaches that payment is made to the seller by the auction company and the agent charges a 2% sales commission (livestock; lines 39-40). Examiner notes that since the payment is made from the auction company to the seller and since the auction company makes a 2% commission, payment information must be sent from the buyer to the auction company. In other words, the only way for the auction company to 1) pay the seller and 2) make a commission is for the buyer to pay the auction company and therefore the auction company MUST receive payment information from the buyer associated with his/her bid. The step of receiving payment information at the auction company (host) from the bidder is necessarily present in the system of EASE as the only way for the auction company to be able to pay the seller and receive a commission.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Electronic Auction Systems (hereinafter EASE) as taught by the following articles "Electronic Agricultural Auctions in the United Kingdom" (hereinafter agricultural) and "Electronic livestock auctions starting in Britain" (hereinafter livestock) in view of Admitted Prior Art.

EASE (as described in detail above) does not specifically teach that the payment information received by the host computer from the bidder includes credit card information and that the credit card information is passed through a clearing house.

Applicant discloses on page 9; line 1 of the specification that credit card clearing techniques are well-known methods of paying for transactions. Examiner notes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of EASE to include payment from the recipient in the form of credit card and credit card clearing as Admitted by Applicant in order to process the transaction (i.e. allow the auction company to get their sales commission).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11, 12, and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 09/253,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present Applicant merely lack receiving a scheduling input. However as argued by Applicant in the Appeal Brief of Application 09/253,014 the act of opening an auction and closing an auction corresponds to scheduling the auction and therefore that information is obviously received in the present Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 14 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 09/253,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present Applicant merely lack receiving a scheduling input. However as argued by Applicant in the Appeal Brief of Application 09/253,014 the act of opening an auction and closing an auction corresponds to scheduling the auction and therefore that information is obviously received in the present Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 15 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 09/253,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present Applicant merely lack receiving a scheduling input. However as argued by Applicant in the Appeal Brief of Application 09/253,014 the act of opening an auction and closing an auction corresponds to scheduling the auction and therefore that information is obviously received in the present Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/253,014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present Applicant merely lack receiving a scheduling input. However as argued by Applicant in the Appeal Brief of Application 09/253,014 the act of opening an auction and closing an auction corresponds to scheduling the auction and therefore that information is obviously received in the present Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 11-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

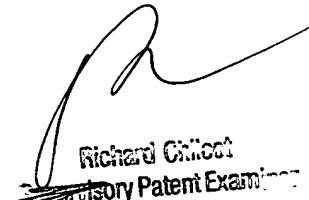
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

JAK


Richard Chikot
~~Patent Examiner~~
~~Technology Center 3627~~
3627